

**Clean Version of the Entire Set of Pending Claims**

1. A pressure sensitive adhesive cover tape having edge portions along its length and comprising:

(a) a polyester substrate having a first surface opposite a second surface;

(b) a layer of an electrically conductive coating disposed on said first surface of said polyester substrate, said electrically conductive coating comprising a dispersion of a conductive polymer selected from the group consisting of polythiophenes and polyanilines, said conductive polymer having a conjugated polymer backbone, said dispersion containing at least one polymeric polyanion compound and at least one binder; and

(c) a layer comprising a polymeric pressure-sensitive adhesive composition disposed on a portion of said layer of electrically conductive coating along said edges of said cover tape;

said cover tape having a degree of clarity from about 80% to about 99%, and a surface resistance of from about  $1 \times 10^4$  Ohm to  $1 \times 10^{12}$  Ohm.

2. The pressure-sensitive adhesive cover tape of claim 1 further comprising a low-adhesion backing releasably adhered to said second surface of said polyester substrate.

3. The pressure-sensitive adhesive cover tape of claim 1 wherein the clarity of said cover tape is from about 90% to about 99%.

4. The pressure-sensitive adhesive cover tape of claim 1, wherein said polythiophene dispersion comprises poly (3,4-ethylenedioxy-thiophene).

5. The pressure-sensitive adhesive cover tape of claim 1, wherein said polymeric polyanion compound comprises at least one acidic polymer being in a form selected from a free acid or a salt form.

6. The pressure-sensitive adhesive cover tape of claim 1, wherein said binder is selected from the group consisting of copolyesters and containing sulfonic acid groups.

### Remarks

Claims 1 to 6 are pending in the present application. A new set of claims has been submitted. Support for amended claim 1 can be found throughout Applicants' written description, such as, e.g., in Figures 2 and 4, on page 9 lines 12 to 17, and on page 9 line 30 to page 10 line 5. Examination and consideration of the application as amended is requested.

#### 35 USC § 112 Rejection

Claims 1 to 6 have been rejected under §112 ¶2 as being indefinite. Applicants appreciate the Examiner's suggested changes to the claims, based on various portions of Applicants' written description.

Applicants have submitted a new version of the pending claims. In particular, claim 1 has been amended to recite that the electrically conductive polymer layer is disposed on the first surface of the polyester substrate and that the pressure sensitive adhesive (PSA) composition layer is disposed on the electrically conductive polymer layer such that the PSA composition layer lies along the edges of the carrier tape.

Applicants submit that with the amended claims, the §112 ¶2 rejection has been overcome and requests that it be withdrawn.

#### 35 USC § 103(a) Rejection

Claims 1 to 6 have been rejected under §103(a) as being unpatentable over Lin (US 6,027,802) either alone or in combination with Abe et al. (US 6,017,610).

According to MPEP 2142, to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references or generally known to one of skill in the art, to modify or combine reference teachings, (2) there must be reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making the changes. Ex parte Chicago Rawhide Manufacturing Co., 226 USPQ 438 (PTO Bd. App. 1984).

Applicants respectfully submit that the references cannot support a *prima facie* case of obviousness as to the claims because, among other possible reasons, the cited references, taken

alone or in combination do not provide a motivation or suggestion to arrive at Applicants' particular cover tape construction.

Lin's invention relates to a cover tape adapted to seal individual electronic components 9 in recesses of a carrier tape. In the embodiment shown in Figures 4, 5A, and 5B, Lin's cover tape includes a randomly embossed layer 12, an adhesive layer 13 covered over one side of the randomly embossed layer 12, and a non-adhesive layer 14 adhered to the adhesive layer 13 to prevent the electronic components 9 from adhering to the adhesive layer 13.<sup>1</sup> The non-adhesive layer 14 can be various plastic films or plastic film with metal vapor deposition or an antistatic agent or the like.<sup>2</sup>

Lin's invention requires a certain ordering of components of his cover tape that differs from that of Applicants' claimed invention. For example, Lin does not require that the conductive layer be disposed on the substrate layer (referred to as a randomly embossed layer) and the adhesive layer disposed on the conductive layer. Instead Lin's invention requires an adhesive layer 13 sandwiched between the randomly embossed layer 12 and the non-adhesive layer 14. Furthermore, Lin's adhesive layer does not lie along the edges of the cover tape. Instead his adhesive layer 13 covers substantially all of the randomly embossed layer as shown in Figures 4, 5A and 5B or cover a center portion of the randomly embossed layer as shown in Figure 8. Lin's invention would not work if the adhesive layer lies only along the edges of the cover tape because he states that the center portion of the randomly embossed layer 12 is adhered to the non-adhesive layer 14 by the adhesive layer 13 to form a compound film having a higher mechanical tensile strength.<sup>3</sup>

Abe's invention relates to a conductive laminate comprising an inorganic or organic substrate and a conductive layer formed on at least a part of a surface of the substrate. The conductive layer has a surface resistance at 25° C and under 15% relative humidity of  $10^6$  to  $10^{12}$  Ohm/m<sup>2</sup>.<sup>4</sup> The organic substrate is a thermoplastic film, such as, polyester among others.<sup>5</sup> The conductive layer contains a conductive polymer such as polyaniline and polythiophenes.<sup>6</sup>

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<sup>1</sup> See Lin '802, Abstract

<sup>2</sup> See Lin '802 at column 6, lines 51-57

<sup>3</sup> See Lin '802 at column 7, lines 5-7

<sup>4</sup> See Abe '610, Abstract

<sup>5</sup> See Abe '610 at column 3, lines 33-37

<sup>6</sup> See Abe '610 at column 3, line 67 and column 4, line 1-5

Abe does not cure the deficiencies of Lin. Even if Abe's conductive layer was substituted into Lin's cover tape for the non-adhesive layer 14, the combination does not lead one skilled in the art to Applicants' claimed construction. There is no suggestion in Abe to place an adhesive layer in a certain portion, e.g., along the edge of the cover tape.

For the above reasons, Applicants submit that its invention is patentable over the cited references and allowance of claims 1 to 6, as amended, at an early date is solicited.

Respectfully submitted,

01 July 2003  
Date

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